

Atty Dkt. No.: SMAR-020
USSN: 10/057,846

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-15, 17-18, 20, 40-44, 46 and 51-54, the only claims pending and under examination in this application.

Claim 1 has been amended to correct typographical errors and simplify the claim language, as well as incorporate the negative limitation of Claim 22. In addition, the previously withdrawn claims have been canceled. As the above amendments introduce no new matter to the application, their entry by the Examiner is respectfully requested.

Claim Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 40-44 and 46 under 35 U.S.C. §112 first paragraph as assertedly failing to comply with the enablement requirement.

The rejected claims recite a method of inhibiting cellular invasion or angiogenesis. In making this rejection, the Examiner contends that the claims are directed to a method of "treatment of cancer generally". The Examiner then suggests that there has never been a compound capable of treating cancer generally and even the most broadly effective anti-tumour agents are only effective against a small fraction of the vast number of different cancers known. The Examiner therefore concludes, "it is beyond the skill of Oncologists today to get an agent to be effective against cancers generally".

The Applicants respectfully disagree with the Examiner regarding lack of enablement. The enablement requirement under 35. U.S.C. §112, first paragraph requires that the "disclosure is sufficient to enable one of skill in the art to carry out the invention commensurate with the scope of the claims" (Amgen v. Chugai (1991) 18

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USPQ 2d 1016 at 1027). To be enabled a specification should contain "sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention" (MPEP 2164.01 p. 2100-179).

In the present application, the claims clearly recite inhibition of cellular invasion and angiogenesis. The specification clearly teaches inhibition of cellular invasion and angiogenesis by numerous compounds falling within the scope of the claims in a variety of different assays and in a variety of cell types, both in vitro and in vivo (p. 23-28). Accordingly, the Applicants respectfully submit that the present claims are enabled.

In view of the above, it is respectfully submitted that claims 40-44 and 46 are fully enabled by the specification and that this rejection under 35 U.S.C. §112, first paragraph may be withdrawn.

Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-15, 17, 40-44, 46 and 51-54 have been rejected under 35 U.S.C. § 112, second paragraph for separately identified issues (a) to (e). Each of these issues is separately addressed below.

(a). In view of the amendment to Claim 1, this issue has been addressed.

(b). In view of the amendment to Claim 1, this issue has been addressed.

(c). Following entry of the above amendment, "NR³⁺" now reads "NR₃+" However, it is unclear as to why the Examiner is requiring the presence of a "counter ion". It is well known in the art that compounds may exist in a charged form, and the identity of the counter ion of a given charged moiety of a compound in a given environment is not necessary to know the metes and bounds of the claimed compound.

(d). With respect to Claim 17, it is submitted that the numbering of this claim is

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not indefinite in view of the Figure 14B. When the claim is read in view of Figure 14B, the recited positions are clear and the metes and bounds of the claim are defined.

(e) Finally, with respect to the phrase "cellular invasion" it is submitted that when this phrase is read in view of the specification, see page 1, lines 20 to 28, it is clear that what is meant by "cellular invasion" is invasion by a cell of other parts of a body, and not invasion of an agent into a cell.

In view of the above remark, the rejection of Claims 1-15, 17, 40-44, 46 and 51-54 under 35 U.S.C. § 112, second paragraph may be withdrawn.

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CONCLUSION

In view of the above remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815.

Respectfully submitted,
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